UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,267	02/29/2000	Shiyan Hua	Cai-15-11	1804

7590 02/26/2004

Fay Sharpe Fagan Minnich & McKee LLP
1100 Supperior Avenue
Seventh Floor
Cleveland, OH 44114-2518

EXAMINER	
GAUTHIER, GERALD	

ART UNIT	PAPER NUMBER
2645	14

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/516,267	HUA ET AL.	
	Examiner	Art Unit	
	Gerald Gauthier	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *28-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28-51* is/are rejected.

7)☒ Claim(s) *41* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/03/2003 has been entered.

Claim Objections

2. **Claim 41** is objected to because of the following informalities: line 12 "the telephone number" lacks of antecedent basis. Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 28-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,061,718) in view of O'Neal et al (US 6,263,064).

Regarding **claim 28**, Nelson discloses an electronic mail delivery method in wired or wireless communications system (column 1, lines 7-12), (which reads on claimed "a method of providing electronic mail messages to a subscriber in a telecommunication network"), the method comprising the steps of:

receiving an electronic mail message (column 5, line 59 "an E-mail message") from a (column 5, line 58 "A person") sender via a network element (column 5, line 60 "uses a personal computer"), the message specifying the subscriber as an intended recipient (column 5, line 59 "to a mobile subscriber") of the electronic mail message (column 5, lines 57-65) [The sender composes an e-mail message using a personal computer to send it to a mobile subscriber via the E-mail delivery system];

where the electronic mail message is to be routed to the subscriber via a telephone (30 on FIG. 3), converting textual content in the electronic mail message (column 6, line 44 "to the text-to-speech converter") to an audio message (column 6, lines 32-52) [The user input a code to have the e-mail message read on the mobile

station the system sends the message to a text-to-speech converter to be read at the loud speaker];

establishing a call to a telephone designated by the subscriber (column 6, lines 11-31) [The MTSO detects that a new message is received sends a message waiting signal to the mobile station which is inherently a phone call to the mobile station]; and

transmitting the audio message to the designated telephone (column 6, lines 32-52) [The MTSO assigns the mobile station channels to transmit the speech message to output via the loudspeaker of the mobile station].

Nelson discloses options for the subscriber but fails to disclose storing the subscriber's electronic mail handling instructions and comparing information in the electronic mail message.

However, O'Neal storing in a network database (120 on FIG. 1) the subscriber's electronic mail handling instructions (column 8, lines 1-21) [The database server represents a data store of subscriber account and communication options];

comparing information in the electronic mail message to the handling instructions stored in the network database for the subscriber (column 8, lines 31-45) [The web server after authenticating the subscriber query the database for current communication options].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use storing the subscriber's electronic mail handling instructions and comparing information in the electronic mail message of O'Neal in the invention of Nelson.

The modification of the invention would offer the capability of storing the subscriber's electronic mail handling instructions and comparing information in the electronic mail message such as the system would permit the subscriber of a plurality of communications services to customize communication options.

Regarding **claim 29**, O'Neal teaches, wherein the handling instructions are customizable by the subscriber and comprise the subscriber's email address, the subscriber's designated telephone for receiving audio messages, and the subscriber's electronic mail truncation instructions (column 8, lines 1-21).

Regarding **claim 30**, O'Neal teaches, wherein the electronic mail message is truncated according to the truncation instructions specified by the subscriber (column 8, lines 31-45).

Regarding **claim 31**, Nelson discloses determining of whether the subscriber also subscribes to a caller identification service for providing caller identification information (column 6, lines 11-31); and

transmitting caller identification information to the telephone designated by the subscriber, the information including an indication that a telephone call received by the subscriber contains an electronic mail message (column 6, lines 11-31).

Regarding **claim 32**, Nelson discloses, wherein the caller identification information further comprises the identity of the sender of the electronic mail message (column 6, lines 11-31).

Regarding **claim 33**, Nelson discloses, wherein the caller identification information further comprises a subject matter identifier of the electronic mail message (column 6, lines 11-31).

Regarding **claim 34**, Nelson discloses, wherein the caller identification information further comprises a portion of the text of the electronic mail message (column 4, lines 11-31).

Regarding **claim 35**, Nelson discloses sending a distinctive ringing pattern corresponding to the inclusion of an electronic mail message in the call (column 6, lines 11-31).

Regarding **claim 36**, Nelson discloses, wherein the email message is not transmitted to a subscriber unless header information in the electronic mail message indicates that the message is urgent (column 6, lines 53-67).

Regarding **claims 37**, Nelson discloses prompting the subscriber to enter a feature activation code, the code comprising a signal to the telecommunication network to store the audio message in a voice mailbox (column 6, lines 11-31); and

storing the audio message in a voice mailbox upon receiving the code (column 6, lines 11-31).

Regarding **claim 38**, Nelson discloses prompting the subscriber to enter a feature activation code, the code comprising a signal to the telecommunication network to repeat the playing of the audio message (column 6, lines 11-31); and

repeating the playing of the audio message upon receiving the feature activation code (column 6, lines 11-31).

6. **Claims 39-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of O'Neal and in further view of Sumar et al (US 5,838,768).

Regarding **claim 39**, Sumar teaches, wherein the telecommunication network includes an automated intelligent network for the automated processing of telephone calls in the network (column 6, lines 58-67).

Regarding **claim 40**, Sumar teaches, wherein the network database comprises a service control point database in the intelligent network (column 7, line 66 to column 8, line 5).

7. **Claims 41-51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumar in view of Nelson.

Regarding **claim 41**, Sumar discloses a system for controlled media conversion in an intelligent network (column 1, lines 35-38), (which reads on claimed "a telecommunication system adapted to provide to a subscriber an audio message converted from an electronic mail message"), the system comprising:

a plurality of communication devices (231 and 232 on FIG. 2) adapted to send and receive telephone calls (column 8, lines 52-64) [The local exchanges are connected to the subscriber terminals to send and receive phone calls];

a plurality of electronic mail (column 6, line 61 "electronic mail") devices adapted to send and receive electronic mail messages (column 7, lines 24-36) [The system is capable to receive a plurality of communication devices such as computer devices];

a service control point (901 on FIG. 9) having call handling control logic (column 12, line 26 "can communicate with a plurality inherently can handle calls") and a database for storing call handling information and electronic mail handling instructions (202 0n FIG. 2), the service control point being adapted to compare header information

in an electronic mail message (column 12, line 39 "the intelligent peripheral notifies the service control point with message information when a message is received for handling instruction") received by the service control point to electronic mail handling instructions (column 12, line 54 "based on the subscriber's preference") stored in the database and to route the electronic mail message to the telephone number specified by the intended subscriber when the handling instructions so indicate (column 12, lines 24-58) [The service control point queries the intelligent peripheral for new messages receives and based on the subscriber preferences send responses to the IP to route the message in a proper format].

Sumar discloses an intelligent peripheral converter from one media to and other but fails to disclose a text-to-audio converter adapted to convert text in an electronic mail message to an audio message.

However, Nelson teaches a text-to-audio converter (48 on FIG. 3) adapted to convert text in an electronic mail message (column 6, line 35 "the E-mail message") to an audio message (column 6, lines 32-52) [The user input a code to have the e-mail message read on the mobile station the system sends the message to a text-to-speech converter to be read at the loud speaker].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a text-to-audio converter adapted to convert text in an electronic mail message to an audio message of Nelson in the invention of Sumar.

The modification of the invention would offer the capability of a text-to-audio converter adapted to convert text in an electronic mail message to an audio message such as the system would deliver e-mail message to a standard telephone.

Regarding **claim 42**, Sumar discloses, wherein the electronic mail handling instructions are customizable by the subscriber and comprise the subscriber's email address, the subscriber's designated telephone for receiving audio messages, and the subscriber's electronic mail truncation instructions (column 12, lines 41-51).

Regarding **claim 43**, Sumar discloses, wherein the electronic mail message is truncated according to the truncation instructions specified by the subscriber (column 12, lines 52-58).

Regarding **claim 44**, Sumar discloses, wherein the service control point is further adapted to determine whether the subscriber subscribes to a caller identification service for providing caller identification information and to transmit caller identification information to the telephone designated by the subscriber, the information including an indication that a telephone call received by the subscriber contains an electronic mail message (column 8, lines 52-64).

Regarding **claim 45**, Sumar discloses, wherein the caller identification information further comprises the identity of the sender of the electronic mail message (column 12, lines 41-51).

Regarding **claim 46**, Sumar discloses, wherein the caller identification information further comprises a subject matter identifier of the electronic mail message (column 12, lines 41-51).

Regarding **claim 47**, Sumar discloses, wherein the caller identification information further comprises a portion of the text of the electronic mail message (column 12, lines 41-51).

Regarding **claim 48**, Sumar discloses, wherein the service control point is further adapted to send a distinctive ringing pattern corresponding to the inclusion of an electronic mail message in the call (column 14, lines 1-7).

Regarding **claim 49**, Sumar discloses, wherein the email message is not transmitted to a subscriber unless header information in the electronic mail message indicates that the message is urgent (column 12, lines 41-51).

Regarding **claim 50**, Sumar discloses, an intelligent peripheral adapted to prompt the subscriber to enter a feature activation code, the code comprising a signal to

the telecommunication system to store the audio message in a voice mailbox (column 12, lines 41-51); and

a voice mailbox adapted to store the audio message upon receiving the code (column 12, lines 41-51).

Regarding **claim 51**, Sumar discloses an intelligent peripheral adapted to prompt the subscriber to enter a feature activation code, the code comprising a signal to the telecommunication system to repeat the playing of the audio message (column 12, lines 41-51); and

a voice mailbox adapted to repeat the playing of the audio message upon receiving the feature activation code (column 12, lines 41-51).

Response to Arguments

8. Applicant's arguments with respect to **claims 28-51** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4800.

Gerald Gauthier
g.g.
February 22, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600